



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,876	11/28/2000	Bryan Julien	300622003110	7402

7590 05/21/2003

RANDOLPH TED APPLE
MORRISON & FOERSTER
755 PAGE MILL ROAD
PALO ALTO, CA 94304-1018

EXAMINER

NASHED, NASHAAT T

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 05/21/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/724,876

Applicant(s)
Julien et al.

Examiner
Nashaat T. Nashed

Art Unit
1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 12, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-44 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 19 6) ☐ Other:

The application has been amended as requested in the communication filed March 12, 2003. Accordingly, claims 15-20, 24, and 25 have been deleted, and new claims 29-44 have been entered.

Claims 29-44 are under consideration.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schupp *et al.* (Schupp, IDS paper number 11, Ref.No. 11: U. S. Patent 6,121,029) in view Khosla *et al.* (Khosla A, U. S. Patent 6,391,594) and Khosla *et al.* (Khosla B, IDS paper number 11, Ref No. 33: WO 97/02358) for the reasons set forth in rejecting original claims 15-17 and 24 in the prior Office action, paper number 16.

In response to the above rejections, Applicants argue that nothing in Schupp suggest any modification to the epoD, much less the specific modification claimed, and neither Khosla A or Khosla B suggest the specific modification or direct the ordinary skill in the art to make the modification of epothilone PKS.

Applicants' arguments filed 3/12/03 have been fully considered but they are not deemed to be persuasive. The pending claims are not limited to a specific modification. The new claims directed to any modification in any of the β -carbonyl modifying activity encoded by a *Sorangium cellulosum* of epoD modules 4-6. The modification could be deletion or substitution by any other from any other PKS. The examiner agrees with the applicants that Schupp *et al.* does not teach modified epoD as evidenced by the fact the rejection is made under 35 U.S.C. 103(a) and not under 35 U.S.C. 102. As indicated in the prior Office action, Schupp *et al.* and Khosla A provide one of ordinary skill in the art with motivation and expectation of success to make derivatives of epothilone which would be very difficult to obtain by organic synthesis. Working with DEBS gene cluster, Khosla *et al.* reported several new compound obtained from deleting and substituting KR2. The claimed modified epoD have not produced any unexpected result or compounds that would have not been expected from the teachings of gene cluster of epothilone taught by Schupp *et al.* and the teaching of modifying various activities of similar PKS from the DEBS gene cluster. While the new claims are narrower in scope than the previously rejected claims

15-17 and 24, they are drawn to non-specific modification which are obvious over the prior art of record. The prior art teach the epoD PKS, and modification of the β -keto group modifying activity result in the formation of new chemical compound belong to a class of compounds that are known to have anticancer and fungal activities. The ordinary skill in the art would have had the skills and the expectation of success. Thus, the claimed invention remain rejected.

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is (703) 305-6586. The examiner can normally be reached Monday, Tuesday, Thursday, and Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on (703) 308-3804. The fax phone numbers for this Group are (703) 305-3014 and (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Nashaat T. Nashed, Ph. D.
Primary Examiner